REMARKS/ARGUMENTS

Favorable reconsideration of this application, in light of the following discussion, is respectfully requested.

Claims 1-10, 12-16, 18, 20, and 21 are pending in the present application.

In the outstanding Office Action, the Amendment filed on December 27, 2006 was objected to under 35 U.S.C. §132(a) for introducing new matter; the drawing filed on December 27, 2005 was objected to for introducing new matter; the specification was objected to under 35 U.S.C. §112, first paragraph, for failing to adequately teach how to make and use the invention; Claims 1, 2, 4, 8-10, 12-14, 18, 20, and 21 were rejected under 35 U.S.C. §103(a) as unpatentable over Babu et al. (U.S. Patent No. 6,122,639, hereinafter Babu) in view of Mauger et al. (U.S. Patent No. 6,937,612, hereinafter Mauger); Claims 3 and 16 were rejected under 35 U.S.C. §103(a) as obvious over Babu in view Mauger, and further in view of Koo (U.S. Patent Publication No. 2001/0032270); and Claims 5-7 and 15 were rejected under 35 U.S.C. §103(a) as obvious over Babu in view of Mauger, and further in view of Buhrke et al. (U.S. Patent No. 5,231,631, hereinafter Buhrke).

With respect to the assertion that the Amendment filed on December 27, 2005 introduced new matter into the specification, Applicant respectfully traverses the position taken in the outstanding Office Action.

"Amendments to the application which are supported in the original description are NOT new matter." *See* MPEP §2163.07, emphasis in original. Furthermore, "[m]ere rephrasing of a passage does not constitute new matter. Accordingly, a rewording of a passage where the same meaning remains in tact is permissible. *In re Anderson*, 471 F.2d

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1237, 176 USPQ 331 (CCPA 1973)."[1] Furthermore, it is well accepted that a satisfactory

description may be in the claims or any other portion of the originally filed specification.[2]

Applicant identifies, for each sentence added to the specification by the Amendment

filed on December 27, 2005, exemplary locations in the originally filed specification that

support the added matter.

--Figure 5 shows a method for managing network devices. At step 502, an advanced

manager is provided that is capable of performing steps 504-512.-- Original Claim 18 states,

inter alia, "A method for managing network devices comprising: providing an advanced

manager."

--At step 504, network devices are queried to determine at least one software

application running on at least one network device.-- Page 11, lines 6-9 of the original

specification states "Advanced manager 210 may also query associate network devices to

determine the software applications running on the associated network device."

--The functionality of at least one network device is classified based upon network

transmission characteristics and the determined software application.-- Page 10, lines 27-30

of the originally filed specification states "[a]dditionaly, advanced manager may also classify

or identify the functionality of a network device based upon the network transmission

characteristics of the network device." Original Claim 11 states, *inter alia*, "classify device

function based upon the determined software applications."

-- In step 508, inter-device transmission data, inter-device negotiation data, bandwidth

negotiation data, and a bandwidth negotiation recommendation are received.-- Page 4, lines

18-23 of the original specification states "...the advanced manager includes a management

engine and an associated database. The management engine receives inter-device

transmission data and inter-device negotiation data...." Original Claim 5 recites, *inter alia*,

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[1] MPEP §2163.07(I)
[2] MPEP §2163(I), and *In re Koller*, 613 F.2d 819, 204 USPQ 702 (CCPA 1980).

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"the management engine operable to receive inter-device transmission data and inter-device negotiation data from at least one network device." Original Claim 7 recites, *inter alia*, "the management engine operable to: receive bandwidth negotiation data and a bandwidth negotiation recommendation from at least one network device."

--In step 510, a policy database is consulted and received data is compared to the policies in the database.-- Original Claim 5 recites, *inter alia*, "compare the received data with the policy database." Original Claim 7 recites, *inter alia*, "compare the bandwidth negotiation data and bandwidth negotiation recommendation with the policy database." Original Claim 20 recites, *inter alia*, "consulting an associated policy data base."

--In step 512, the at least one network device is managed according to the determined functionality.-- Original Claim 1 recites, *inter alia*, "manage the at least one network device based upon the determined functionality."

--Managing may include submitting management instructions and a bandwidth recommendation based on a policy database.-- Original Claim 20 recites, *inter alia*, "submitting management instructions based on the associated policy database." Original Claim 7 recites, *inter alia*, "the management engine operable to...submit a revised bandwidth recommendation based on the policy database."

In view of the above identified support for the matter added to the specification by the Amendment filed on December 27, 2005, Applicant respectfully submits that no new matter was added. Accordingly, Applicant respectfully requests that the objection for adding new matter be withdrawn.

With respect to the assertion in the outstanding Office Action that Fig. 5, added by the Amendment Filed on December 27, 2005 adds new matter, Applicant respectfully requests that this object be withdrawn for at least the reasons stated above.

The outstanding Office Action appears to combine a rejection for lack of written description and a rejection for lack of enablement. The outstanding Office Action, on page 3, states "i.e. failing to provide an enabling disclosure." However, the outstanding Office Action on pages 3-4 states the test to be applied under the written description requirement of 35 U.S.C. §112, first paragraph. Applicant notes that the requirement for lack of written description and lack of enablement are distinct from each other. *See* MPEP 2161.

However, in order to move prosecution forward, Applicant will explain why the specification includes an adequate written description and that the specification discloses, to one of ordinary skill in the art, how to make and use the invention defined by the claims.

An Applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). Furthermore, Applicant notes that there is a strong presumption that an adequate written description of the claimed invention is present when the application is filed. *In re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976). Moreover, MPEP §2163(II)(A) states that the "rejection of an original claim for lack of written description should be rare."

The outstanding Office Action, at page 5, states "**The specification fails** to describe the advanced manager operable to 'classify a functionality of the at least one network device via the one network communication port based upon network transmission characteristics of the at least one network device and the determined software application'" (emphasis in original). Although the outstanding Office Action cites portions of the specification in attempt to highlight a deficiency, the outstanding Office Action does not consider the entire specification. For example, the specification at page 10, lines 15-25 states

> The connection of **advanced manager 210 with the network communication ports** 222, 224, 226, 228, and 230 or

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> network elements 212, 216, 214, 220, and 218, **respectively
> enable advanced manager** to identify and **classify the function
> of each network element**. Initially, when a network environment
> comes online, each network element preferably performs an
> initiation procedure that advertises the existence of the network
> element to connected elements. In the present embodiment,
> advanced manager 210 receives these initialization
> communications [emphasis added].

Furthermore, original Claim 11 states, *inter alia*, "the advanced manager operable

to...**classify device function based upon the determined software applications**"

(emphasis added). Page 10, lines 27-30 of the originally filed specification states

"[a]dditionaly, advanced manager may also classify or identify the functionality of a network

device based upon the network transmission characteristics of the network device."

Accordingly, the specification clearly describes the claimed "classify a functionality

of the at least one network device via the one network communication port based upon

network transmission characteristics of the at least one network device and the determined

software application."

The outstanding Office Action also states "**The specification fails** to describe the

advanced manager operable to...'managing the at least on network device based upon the

classified functionality (claim 1)'" (emphasis in original). Although the outstanding Office

Action cites portions of the specification in attempt to highlight a deficiency, the outstanding

Office Action does not consider the entire specification.

For example, original claim 1 recites "**manage the at least one network device

based upon the determined functionality.**" Furthermore, the specification at page 10, line

27 to page 11, line 6 states

> Additionally, **advanced manager may also classify** or
> identify **the functionality of a network device based upon
> the network transmission characteristics of the network
> device.** This classification may include determining that a
> network device primarily transmits particular types of
> transmissions such as an audio stream, video stream, or simple

> data stream. **Advanced manager 210 may then manage these
> different types of devices according to their transmission
> characteristics.** (emphasis added).

Accordingly, the specification clearly describes the claimed "manage the at least one

network device based upon the classified functionality"

The outstanding Office Action also states "**The specification fails** to describe the

advanced manager operable to...'receive inter-device transmission data and inter-device

negotiation data from at least one network device and to compare the received inter-device

transmission data and inter-device negotiation data with the policy database (claim 5)'"

(emphasis in original). Although the outstanding Office Action cites portions of the

specification in attempt to highlight a deficiency, the outstanding Office Action does not

consider the entire specification. For example, original Claim 5 recites,

> The system of claim 1 further comprising: the advanced
> manager having a management engine and a policy database;
> the management engine operable to **receive inter-device
> transmission data and inter-device negotiation data from at
> least one network device and compare the received data
> with the policy database**; and the management engine further
> operable to direct the at least one network device according to
> the policy database.

The amendment to Claim 5 in the Amendment filed on December 27, 2005 merely corrected

an antecedent basis informality pertaining to the phrase "received data" by changing

"received data" to "received inter-device transmission data and the inter-device negotiation

data." Furthermore, the specification, at page 4, lines 20-23, states "The management engine

receives inter-device data and inter-device negotiation data and compares the received data

with the policy database."

Accordingly, the specification clearly describes the claimed "receive inter-device

transmission data and inter-device negotiation data from at least one network device and to

compare the received inter-device transmission data and the inter-device negotiation data

with the policy database."

The outstanding Office Action also states "**The specification fails** to describe the

advanced manager operable to…'receive bandwidth negotiation data and a bandwidth

negotiation recommendation from at least one network device' and 'compare the bandwidth

negotiation data and bandwidth negotiation recommendation with the policy database (claim

7 and 15)'" (emphasis in original). Although the outstanding Office Action cites portions of

the specification in attempt to highlight a deficiency, the outstanding Office Action does not

consider the entire specification. For example, original Claim 7 recites,

> The system of claim 5 further comprising the
> management engine operable to: **receive bandwidth
> negotiation data and a bandwidth negotiation
> recommendation from at least one network device;
> compare the bandwidth negotiation data and bandwidth
> negotiation recommendation with the policy database**; and
> submit a revised bandwidth recommendation based on the
> policy database.

Furthermore, Applicants note that Claims 7 and 15 were only amended during prosecution to

correct self-evident matters pertaining to form and grammar.

Accordingly, the specification clearly describes the claimed "receive bandwidth

negotiation data and a bandwidth negotiation recommendation from at least one network

device; compare the bandwidth negotiation data and bandwidth negotiation recommendation

with the policy database."

In view of the above discussion, Applicant respectfully submits that the specification

satisfies the written description requirement as the specification clearly conveys to a person

of ordinary skill in the art that the inventor had possession of the later claimed subject matter

when the application was filed.

With respect to any assertion that the specification does not include an enabling disclosure, Applicant respectfully traverses any such assertion and respectfully requests that any rejection for lack of enablement be withdrawn.

The enablement requirement of 35 U.S.C. §112, first paragraph, requires that the subject matter of the claims be described so as to enable one skilled in the pertinent art to make and use the claimed invention.[3] The test of enablement is whether one reasonably skilled in the art could make or use the claimed invention from the disclosures in the patent coupled with information known in the art without undue experimentation. *See United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988).

Furthermore, Applicants note that the disclosure is presumed valid, and the Examiner has the burden providing reasons for uncertainty of enablement.[4] In the outstanding Office Action the Examiner appears to take the position that the specification is not enabling because certain claim elements are not supported by the originally filed specification. However, as noted above, the specification fully supports all the claims elements that the outstanding Office Action suggests were not adequately described in the specification. Accordingly, Applicants respectfully submit that any rejection under 35 U.S.C. §112, first paragraph, for lack of enablement be withdrawn.

With respect to the rejection of Claims 1-10, 12-16, 18, and 20-21 under 35 U.S.C. §112, first paragraph, Applicant respectfully requests that this rejection be withdrawn for at least the reasons stated above.

With respect to the rejections based on art, Applicant respectfully traverses the outstanding ground of rejection because the outstanding Office Action fails to provide a *prima facie* case of obviousness by asserting prior art that, no matter how the prior art references are combined, does not teach every element of independent Claim 1.

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[3] MPEP § 2164.01.
[4] MPEP §2164.04

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To establish a *prima facie* case of obviousness, MPEP §2143 requires that three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the references teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim elements. The outstanding Office Action is deficient with respect to the third requirement.

With respect to the rejection of Claim 1 under 35 U.S.C. §103(a) as unpatentable over Babu in view of Mauger, Applicant respectfully traverses the rejection. Claim 1 recites, *inter alia*, "query at least one of the plurality of network devices to determine at least one software application running on each one of the plurality of network devices, classify a functionality of the at least one network device via the one network communication port based upon network transmission characteristics of the at least one network device and the determined software application."

The outstanding Office Action relies on Babu to disclose or suggest the claimed "query at least one of the plurality of network devices to determine at least one software application running on each one of the plurality of network devices." However, Babu does not disclose or suggest querying a network device to determine a software application running on the device.

On the contrary, Babu merely discloses that collection engine 20 collects data from network device 118.[5] Collection engine 20 collects information from network device 118 by sending network device 118 an SNMP message. The SNMP message queries the device to ask the network device 118 to identify itself by providing a device type identifier.[6] The

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[5] Babu, col. 7, lines 27-29.
[6] Babu, col. 7, lines 36-39.

network device 118 responds to the SNMP message by providing a device type identifier, such as a system object identifier.[7]

When the SNMP query for a device type identifier is successful, network device 118 will also provide basic device data that represents basic information about the device. The basic device data includes a device name, domain name in which the device is located, and a device type code that identifies the specific type of device that has responded.[8]

Babu does not disclose or suggest that the collection engine queries a network device to determine at least one software application running on the network device. The collection engine only sends a query to determine a device identifier.

Col. 13, lines 14-17 of Babu merely describes that different network devices may include different software. This section of Babu does not disclose or suggest that the collection engine sends a query to determine a software application running on the network device.

Furthermore, Babu does not disclose or suggest the claimed "classify a functionality of the at least one network device...based upon network transmission characteristics of the at least one network device and the determined software application."

Since Babu does not disclose or suggest determining a software application running on a network device, Babu cannot disclose or suggest using the determined software application to classify a functionality of the at least one network device. Furthermore, Applicant notes that the outstanding Office Action states "Babu does not disclose the process of classify a functionality of at least one network device via the one network communication port **based upon network transmission characteristics of the at least one network device**" (emphasis in original).[9]

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[7] Babu, col. 7, lines 43-48.
[8] Babu, col. 7, line 66 to col. 8, lines 1-6.
[9] Office Action, page 7.

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Furthermore, Applicant notes that <u>Babu</u> only discloses mapping the device type identifier from the network device to a stored list of device types in order to determine whether the device type of the responding network device is known and can be handled.[10] <u>Babu</u> does not disclose or suggest that determined software and network transmission characteristics are involved in this mapping operation.

Applicant respectfully submits that <u>Mauger</u> does not cure the above-noted deficiencies in <u>Babu</u>. <u>Mauger</u> does not disclose or suggest determining the software running on the network device, and using the **determined software and network transmission characteristics** to classify a functionality of the network device.

With respect to the reference to Claims 18-25 of <u>Mauger</u>, the rejection of the present Application, based on reference to patent claims is clearly improper. The Federal Circuit has characterized analysis of prior art patent claims with respect to the patentability of an Application as "a plainly indefensible line of reasoning" (*In Re* <u>Benno</u>, 226 U.S.P.Q. 683, 686, Fed. Cir. 1985) and further stated that:

> The scope of a patent's claim determines what infringes the patent; <u>it is no measure of what it discloses</u>. A patent discloses only that which it describes, whether specifically, or in general terms, so as to convey intelligence to one capable of understanding (*See* <u>Benno</u> at 686) (emphasis added)).

In view of the above-noted distinctions, Applicant respectfully submits that Claim 1 (and dependent Claims 2-10, and 12) patentably distinguishes over <u>Babu</u> and <u>Mauger</u>, taken alone or in proper combination. In addition, Applicants respectfully submit that independent Claims 13, 18, and 21 (and Claims 14-16, and 20 dependent thereon) patentably distinguish over <u>Babu</u> and <u>Mauger</u>, taken alone or in proper combination, for at least the reasons stated for amended Claim 1.
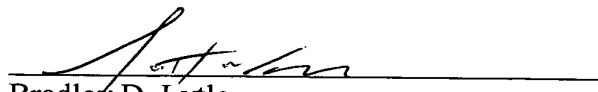
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[10] <u>Babu</u>, col. 8, lines 7-13.

Furthermore, <u>Koo</u>, and <u>Buhrke</u> do not cure the above-noted deficiencies in <u>Babu</u> and <u>Mauger</u>.

Consequently, in light of the above discussion, the present application is believed to be in condition for allowance and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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